

CERTIFICATE OF MAILING BY "EXPRESS MAIL"
UNDER 37 C.F.R. § 1.10

"Express Mail" mailing label number: EV305596557US Date of Mailing: July 27, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service, utilizing the "Express Mail Post Office to Addressee" service addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313,

Tracey Copelan

DOCKET ONYX1047-DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Yuqiao Shen et al

SC/Serial No.: 10/669,768

Filed: September 24, 2003

Title: Adenovirus E1B-55K Single Amino
Acid Mutants and Methods of Use

PATENT APPLICATION

Art Unit 1614

Examiner: Unassigned

Confirmation No. 8135

PETITION TRANSMITTAL

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the "Notice Of Incomplete Non-Provisional Application," dated December 10, 2002, Applicants through their Attorney of Record hereby submit the following:

- ☒ Notice Of Incomplete Non-Provisional Application mailed July 7, 2004
- ☒ Withdrawal of Previously Sent Notice mailed July 7, 2004
- ☒ Return Receipt Postcard with USPTO Acknowledgement stamp - **Exhibit A.**

- ☒ Copy of the Application Transmittal of September 24, 2003 - **Exhibit B.**
- ☒ Copy of the Oath and Declaration for priority application 09/918,696, filed July 30, 2001, filed with instant application on September 24, 2003 - **Exhibit C.**
- ☒ Authorization to charge the Petition Fee of \$130.00 (37CFR§ 1.17(h)), or any other fees associated with this to Deposit Account No. 15-0615.
- ☒ Return Receipt Postcard
- ☒ Certificate of Mailing by Express Mail Label EV305596557US

Respectfully submitted,

Dated: 7/27/04

By: Gregory Giotta
Gregory Giotta
Reg. No. 32,028

ONYX Pharmaceuticals, Inc.
3031 Research Drive
Richmond, California 94806
Telephone (510) 222-9700



07-28-04

IPW

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DOCKET ONYX1047-DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Yuqiao Shen et al

SC/Serial No.: 10/669,768

Filed: September 24, 2003

Title: Adenovirus E1B-55K Single Amino
Acid Mutants and Methods of Use

PATENT APPLICATION

Art Unit 1614

Examiner: Unassigned

Confirmation No. 8135

PETITION IN RESPONSE TO
NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the "Notice Of Incomplete Non-Provisional Application," dated December 10, 2002, Applicants through their Attorney of Record petition that the Notice be withdrawn for the following reasons, and that Applicants' patent application be

07/29/2004 HRL111 00000107 150615 10669768
01 FC:1460 130.00 DA

accorded the filing date of U.S. Serial No. 10/669,768, which was filed September 24, 2003.

The instant application is a divisional application of U.S. Application Serial No. 09/918,696, filed July 30, 2001, now Patent No. 6,635,244, which claims priority from U.S. Provisional Application no. 60/222,887 filed August 3, 2000.

The "NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION" ("Notice") is requiring, first; that Applicants submit a new of the Oath and Declaration for the instant application. A New Oath and Declaration is not required under 37 CFR §1.53 (b)(1), provided a copy of the Oath and Declaration to which the instant application claims priority id presented at the time of filing of the instant application. A copy of the Oath and Declaration was submitted to the USPTO at he time of filing as indicated and acknowledged by the USPTO on the Return receipt card copy of which is attached as **Exhibit A**. A Copy of the Application Transmittal indicating all items forwarded to the USPTO on September 24, 2003 is attached as **Exhibit B**. A copy of the Oath and Declaration filed with the application on September 24, 2003 is also attached as **Exhibit C**. All the requirements pursuant to 37 C.F.R. §1.56(d) are met

Second, the Notice request Applicants to submit drawings, as set forth in their specification to be granted the filing date of September 24, 2003. Drawings were submitted to the USPTO as indicated in Exhibit A and Exhibit B.

Applicants respectfully request that their petition be granted and that the instant patent application be accorded a filing date of September 24, 2003.

The Commissioner is hereby authorized to charge the Petition Fee of \$130.00 (37CFR§ 1.17(h)), or any other fees associated with this Petition or Action to Deposit Account No. 15-0615.

A duplicate copy of this communication is enclosed

Respectfully submitted,

Dated: 7/27/04

By: Gregory Giotta
Gregory Giotta
Reg. No. 32,028

ONYX Pharmaceuticals, Inc.
3031 Research Drive
Richmond, California 94806
Telephone (510) 222-9700



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/669,768	09/24/2004	Yuqiao Shen	ONYX1047-DIV

37499
 ONYX PHARMACEUTICALS, INC.
 3031 RESEARCH DRIVE
 RICHMOND, CA 94806



CONFIRMATION NO. 8135
 FORMALITIES LETTER



OC000000013159468

Date Mailed: 07/07/2004

NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

A filing date has NOT been accorded to the above-identified application papers for the reason(s) indicated below.

All of the items noted below and a newly executed oath or declaration covering the items must be submitted within **TWO MONTHS** of the date of this Notice, unless otherwise indicated, or proceedings on the application will be terminated (37 CFR 1.53(e)). Replies should be mailed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

The filing date will be the date of receipt of all items required below, unless otherwise indicated. Any assertions that the item(s) required below were submitted, or are not necessary for a filing date, must be by way of petition directed to the attention of the Office of Petitions accompanied by the \$130.00 petition fee (37 CFR 1.17(h)). If the petition states that the application is entitled to a filing date, a request for a refund of the petition fee may be included in the petition. Petitions should be mailed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

- The application was deposited without drawings. 35 U.S.C. 113 (first sentence) requires a drawing "where necessary for the understanding of the subject matter sought to be patented." *Applicant should reconsider whether the drawings are necessary under 35 U.S.C. 113 (first sentence).*

Replies should be mailed to: Mail Stop Missing Parts
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

*A copy of this notice **MUST** be returned with the reply.*

COPY

Customer Service Center
 Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

COPY



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
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 Alexandria, Virginia 22313-1450
 www.uspto.gov

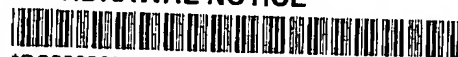
APPLICATION NUMBER	FILING OR 371(e) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/669,768		Yuqiao Shen	ONYX1047-DIV

37499
 ONYX PHARMACEUTICALS, INC.
 3031 RESEARCH DRIVE
 RICHMOND, CA 94806



CONFIRMATION NO. 8135

WITHDRAWAL NOTICE



OC000000013074830

Date Mailed: 07/07/2004

WITHDRAWAL OF PREVIOUSLY SENT NOTICE

The Notice mailed on 01/02/2004 was sent in error and is hereby withdrawn. A corrected Notice is enclosed. The time period for reply runs from the mail date of the corrected Notice. We apologize for any inconvenience this caused.

COPY

A copy of this notice MUST be returned with the reply.

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

SERIAL NO. (Application Patent, Interference, Opposition, Registration) Unassigned
ATTY. DOCKET # Onyx 1047-DIV Filing, Issue or Registration Date Even date
APPLICANT Yuguao Shen, Julie Nye + Jerry Hermiston
TITLE Adenovirus E1B-55K Single Amino Acid Mutant and
Methods of Use

☒ CERTIFICATE OF MAILING: EV 305546747 US CERTIFICATE OF EXPRESS MAIL: Hand Delivered

THE U.S. PATENT & TRADEMARK OFFICE ACKNOWLEDGES RECEIPT OF Preliminary (6 pages)

☒ Transmittal Letter 4 pages ☐ Amendment _____
24 Pages Specification _____ _____ Petition _____
2 Pages Claims: 19 Number of Claims _____ Motion _____
1 Abstract _____ Notice of Appeal _____ Copies _____
_____ Declaration _____ Signed _____ In Blank _____ Appeal Brief _____
_____ Assignment _____ Issue Fee (PTOL 85b * 85c) _____
_____ Power of Attorney _____ Information Disclosure Statement _____
6 Sheets of Drawings: ☒ Formal: _____ Informal _____ Form 1499: _____ with References _____
☒ Fee Authorization to charge Deposit Account No. 15-0615 \$ 190.00

Check(s) totaling \$ 14 pages Sequence Listings + CRF diskette
✓ Copy of 09/19/16 696 Declaration + Assignment
✓ Statement Under 1.825
✓ copy of priority application 09/19/16, 696

2215 * U.S. PTO
10/669768
09/24/03



Exhibit A



CERTIFICATE OF MAILING BY "EXPRESS MAIL"
UNDER 37 C.F.R. § 1.10

"Express Mail" mailing label number: EV305596747US

Date of Mailing: 9/24/03

I hereby certify that this correspondence is being deposited with the United States Postal Service, utilizing the "Express Mail Post Office to Addressee" service addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313, Mail Stop - Patent Application and mailed on the above Date of Mailing with the above "Express Mail" mailing label number.

(Signature)

DOCKET ONYX1047-DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application
Yuqiao Shen
Julie Nye
Terry Hermiston

PATENT APPLICATION

Art Unit 1636

Examiner: Maria Marvich

SC/Serial No.: Unassigned

Filed: Even date herewith

Title: Adenovirus E1B-55K Single Amino
Acid Mutants and Methods of Use

APPLICATION TRANSMITTAL LETTER FOR A DIVISIONAL
PATENT APPLICATION UNDER 37 C.F.R. §1.53(b)

Mail Stop: Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing is a Divisional Patent Application, of U.S.
Application Serial No. 09/918,696, filed July 30, 2001, which claims priority from U.S.
Application Serial No. 60222,887, filed August 3, 2000, identified as follows:

Exhibit B

Inventor(s): Yuqiao **SHEN**, of Richmond, California
Julie **NYE**, of Berkeley, California
Terry **HERMISTON**, Corte Madera

Title: **ADENOVIRUS E1B-55K SINGLE AMINO ACID MUTANTS
AND METHODS OF USE**

No. of pages in Specification: 24

No. of pages of Claims 2 No. of Claims: 19.

No. of Sheets of Drawings: 6.

No. of pages of Sequence Listings 14

Also enclosed are:

- [X] Copy of original declaration form Serial No. 09/918,696.
- [X] Copy of recorded Assignment from Serial No. 09/918,696.
- [X] A copy of a priority application as originally filed.
- [X] Statement Under 1.825
- [X] CRF (Diskette) and Paper Copy of Sequence Listings
- [X] A Preliminary Amendment.

The filing fee pursuant to 37 C.F.R. § 1.16 is determined as follows:

No. Filed	No. Extra	Rate Small Entity/Large Entity	
Basic Fee		\$.00/ 790.00	
		=	<u>\$790.00</u>
Total Claims	<u>19</u> -20 = <u>0</u>	X \$.00 /18.00	
		=	<u>\$0.00</u>
Independent Claims	<u>2</u> -3 = <u>0</u>	X \$.00/ 84.00	
		=	<u>\$0.00</u>
First Presentation of Multiple Dependent Claim(s)	<u>0</u>	\$.00/ 00.00	
		=	<u>\$0</u>
Total:			= <u>\$790.00</u>

*If the difference is less than zero, enter "0".

[X] Please charge Deposit Account No. 15-0615 in the amount of \$ 790.00 A duplicate copy of this authorization is enclosed.

[X] The Commissioner is hereby authorized to charge any fees associated with this communication (including those listed below) to Deposit Account No. 15-0615. A duplicate copy of this authorization is enclosed.

[X] Any additional filing fees under 37 C.F.R. § 1.16.

[X] Any patent application processing fees under 37 C.F.R. § 1.17.

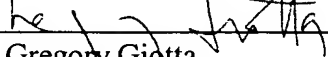
This application is filed pursuant to 37 C.F.R. § 1.53 in the name of the above-identified Inventor(s).

Please direct all correspondence concerning the above-identified application to the following address:

Customer No. 37499
Gregory Giotta, Ph.D.
Vice President and Chief Legal Counsel
ONYX Pharmaceuticals, Inc.
3031 Research Drive
Richmond, California 94806
Telephone: (510) 262-8710

Respectfully submitted,

Date: 9/24/03

By: 
Gregory Giotta
Reg. No. 32,028

ONYX Pharmaceuticals, Inc.
3031 Research Drive
Richmond, California 94806
Telephone: (510) 222-9700
Facsimile: (510) 222-9700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application)	<u>PATENT APPLICATION</u>
)	
Inventor(s): Yuqiao Shen)	
Julie Nye)	
Terry Hermiston)	
)	
SC/Serial No.: 09/918,696)	
)	
Filed: July 30, 2001)	
)	
Title: Adenovirus E1B-55K Single)	
Amino Acid Mutants and)	
Methods of Use)	
)	

DECLARATION FOR PATENT APPLICATION
AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name; I believe that I am the original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

ADENOVIRUS E1B-55K SINGLE AMINO ACID MUTANTS
AND METHODS OF USE

the specification of which (check applicable ones):

☐ is filed herewith;

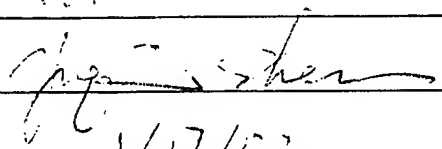
☒ Claims priority to U.S. Provisional Application No. 60/222,887,
filed on August 3, 2000.

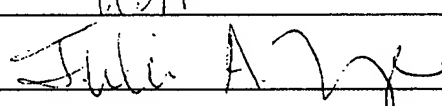
☒ was filed with the above-identified "Filed" date and "SC/Serial
No."

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose information which is material to the examination of the application in accordance with Title 37, Code of Federal Regulations, §1.56.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

POWER OF ATTORNEY: As a named inventor, I hereby appoint Gregory Giotta, Reg. No. 32,028 and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

- (1) Full name of sole
or first inventor: Yuqiao Shen
- (1) Residence: 3400 Richmond Parkway, Apt. 2317, Richmond, CA 94806
- (1) Citizenship: USA
- (1) Inventor(s) signature: 
- (1) Date: 1/17/02

- (2) Full name of second
joint inventor: Julie Nye
- (2) Residence: 954 San Benito Rd., Berkeley, CA 94707
- (2) Citizenship: USA
- (2) Inventor(s) signature: 
- (2) Date: 1/23/02

- (2) Full name of third
joint inventor: Terry Hermiston
- (2) Residence: 9 Seamast Passage, Corte Madera, CA 94925
- (2) Citizenship: USA
- (2) Inventor(s) signature: Terry Hermiston
- (2) Date: 12/17/01